UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,850	10/10/2000	Marjorie Mossman Peffly	8287	4193

27752 7590 09/03/2002

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER	
BENNETT, RACHEL M	
ART UNIT	**PAPER NUMBER**
1615	16

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/685,850	Applicant(s) PEFFLY ET AL.	
	Examiner Rachel M. Bennett	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46 and 53-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46 and 53-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. In view of the Appeal Brief filed on 6/28/02, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20, 53-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending

Application No. 09/685,536 in view of McKay (US 5,325,878). McKay is relied on for the teaching of an applicator comprising a matrix comprising a hair agent (see abstract and figures).

It is the position of the examiner that it would have been obvious to one of ordinary skill in this art at the time of invention to modify the composition taught by the instant application by adding the composition to the applicator taught by McKay because McKay teaches using an applicator to apply a composition to the hair and scalp. The expected result would be an applicator comprising a scalp composition.

This is a provisional obviousness-type double patenting rejection.

Specification

3. Claims 1-46, 53-69 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-12, 15-18,21-32, 35-38, 53-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. (US 4940578).

Yoshihara discloses a hair preparation comprising an oil-absorptive substance and an anti-dandruff agent (see abstract). The base of the hair preparation is a mixture of water and ethanol (see col. 6 lines 20-26). The anti-dandruff agent is zinc pyrithione (see col. 8 and examples). The hair preparation may also contain other ordinary components in such amounts that they do not damage the effect of the preparation. The components in include surfactants,

humectants, and vitamins (see col. 6 lines 36-46 and col. 10 lines 54-58). The scalp lotion is applied after shampooing and drying the scalp with a towel (see col. 12 lines 63-68 and col. 13 lines 1-7). Yoshihara is deficient in the since that this reference fails to teach the combination of all the above elements combined in a specific example.

It is the position of the examiner that it would be obvious to one of ordinary skill in this art, at the time of invention, by routine experimentation, to combine the elements taught by the reference into one composition, determining the preferred amount of each component as desired by applicant to achieve the desired results. The reference desires a scalp composition comprising an anti-dandruff agent. The expected result would be a scalp composition comprising ethanol, zinc pyrithione and a humectant.

6. Claims 13, 19, 20,33, 39, and 40 are rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over Kashibuchi et al. (US 5565207).

Kashibuchi discloses a scalp moisturizer comprising an active ingredient (see abstract). Alcohols may be included in the composition (see col. 6). The moisturizer may contain additional active ingredients such as zinc pyrithione, menthols, surfactants, allantoin, vitamin E. Humectants may also be included (see col. 6). Kashibuchi discloses the following tests: A) test for recovery of regularity of cellular arrangement of scalp corneocytes and for the improvement in multi-layer desquamation; B) visual observation of scalp lesions and C) test for hair moisturizing effect. Kashibuchi is deficient in the since that this reference fails to teach the combination of all the above elements combined in a specific example.

It is the position of the examiner that it would be obvious to one of ordinary skill in this art, at the time of invention, by routine experimentation, to combine the elements taught by the

reference into one composition, determining the preferred amount of each component as desired by applicant to achieve the desired results. The reference desires a scalp composition comprising an allantion, vitamin E and menthol and alcohols. The expected result would be a composition comprising an active ingredient to be applied to the scalp.

7. Claims 14, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. (US 4940578) and further in view of McKay (US 5325878).

Yoshihara, as disclosed above, teaches a scalp composition. Yoshihara does not teach the composition be contained in an applicator. McKay is relied on for the teaching of an applicator comprising a matrix comprising a hair agent (see abstract and figures).

It is the position of the examiner that it would have been obvious to one of ordinary skill in this art at the time of invention to use the teachings of McKay with regard to using an applicator to apply a composition to the scalp in the teachings of Yoshihara because McKay teaches a hair composition as in Yoshihara. Both Yoshihara and McKay desire the composition to be applied to the hair and scalp. The expected result would be an applicator comprising a scalp composition.

8. Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. (US 4940578) and McKay and in further in view of Kellett et al. (US 5002075).

Yoshihara, as disclosed above, teaches a scalp composition. McKay as disclosed above, teaches a fluid-dispensing comb to apply a composition. Yoshihara does not teach an insecticidal agent in the composition. Kellett is relied on for the teaching of an applicator comprising a matrix comprising a hair-conditioning agent, specifically an insecticidal agent (see col. 13) and a surfactant (see abstract and figures).

It is the position of the examiner that it would have been obvious to one of ordinary skill in this art at the time of invention to use the teachings of Kellett with regard to using an insecticidal agent in a scalp composition in the teachings of Yoshihara and McKay because Kellett teaches a hair composition applied with an applicator as in Yoshihara and McKay. The expected result would be an applicator comprising a scalp composition for treating fleas and ticks.

Response to Arguments

9. Applicant's arguments filed 6/28/02 have been fully considered but they are not persuasive.

Rejection under 103(a) over Yoshihara et al.

The Declaration of Marjorie Mossman Peffly filed under 37 CFR 1.132 has been entered and considered but does not overcome the rejection of claims 1-12, 15-18, 21-32, 35-38, 53-60 based on Yoshihara et al. as set forth in the last action because: it is the position the examiner it would have been obvious to one of ordinary skill in the art at the time the invention was made to "add other ordinary components", (as suggested by Yoshihara) such as humectants, specifically glycerol or dipropylene glycol to the scalp treatment in order to provide moisturization. Humectants, by definition, are substances that promote retention of moisture. Therefore, by adding humectants, as suggested by Yoshihara, moisturization of the scalp would be obtained. Moreover, the scope of the claims is broader than the scope of the Declaration. The Declaration is limited to 5% glycerine. The claims are not limited by glycerine or a by 5% of glycerine. The instant claims also have "further comprising" ingredients.

Rejection under 103(a) over Kashibuchi et al.

Applicants argue Kashibuchi et al. does not teach a volatile liquid in combination with a humectant and skin active agent and Kashibuchi teaches away from the use of large amount of humectants. However, the examiner refers to the teaching of Kashibuchi at col. 6 lines 10-16, 48-57 where other ingredients such as alcohols may be incorporated into the scalp moisturizer. Also, at col. 6 lines 45-47, humectants may also be incorporated into the scalp moisturizer. Applicant is claiming the amount of humectant be from about .01% to 20%, more preferably from about 1% to about 10%. Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention to use a lower amount of humectant, as desired by the reference and applicant, in order to achieve the desired results claimed by applicant.

Rejection under 103 (a) over Yoshihara et al. in view of McKay (and in further view of Kellett)

Applicants argue the reference does not teach the fluid be applied to the scalp but the hair. It is the position of the examiner that the composition of Yoshihara, as being applied to hair would simultaneously be applied to the scalp. Therefore it would have been obvious to one of ordinary skill in this art to use the composition taught by Yosihara in the applicator taught by McKay because of the expectation of delivering the composition to the hair and the scalp.

Applicants also argue the comb of McKay would unduly affect hair cosmetics. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicator not unduly affecting hair cosmetics) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel M. Bennett whose telephone number is (703) 308-8779. The examiner can normally be reached on Monday through Friday, 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 309-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

R. Bennett
August 27, 2002

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600